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09/062,552	04/20/98	SHIRAIWA	Y 35.62135

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EXAMINER

WALLERSON, M

ART UNIT

PAPER NUMBER

2622

16

DATE MAILED: 03/14/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/062,552

Applicant(s)
Shiraiwa

Examiner
Mark Wallerson

Group Art Unit
2622



☒ Responsive to communication(s) filed on Jan 2, 2001

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-79 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-79 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Part III DETAILED ACTION

Notice to Applicant(s)

1. This action is responsive to the following communications: amendment filed on 1/2/2001.
2. This application has been reconsidered. Claims 1-79 are pending.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 6, 7, 8, 11, 15, 21, 39-42, 47, 52, 55, 57, 59, and 61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claims 1, 6, 7, 8, 11, 15, 21, 39-42, 47, 52, 55, 57, 59, and 61 recite the limitation "the on-state and the off-state" in the claims. There is insufficient antecedent basis for this limitation in the claim.

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Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

7. Claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22-26, 27, 28, 29, 30, 31, 32, 33, 34, 37, 38, 39, 40, 41, 42, 43, 44, 45, 46, 47, 48, 49, 50, 51, 52, 53, 54,

57, 58, 59, 60, 61, 62, 63, 64, 65, 66, 67, 68, 69, 70, 71, 72, 73, 74, 75, 76, 77, 78, and 79 are rejected under 35 U.S.C. 102(e) as being anticipated by Parulski et. al. (hereinafter referred to as Parulski) (U. S. 5,633,678).

With respect to claims 1, 2, 3, 28, 32, 43, 44, 48, 51, 62 (as best understood), 63, and 64, Parulski discloses a memory medium (24) for use in a memory medium reading device (5), the memory medium storing image data for a plurality of images (the abstract, lines 10-14 and column 2, lines 38-39) and image-reproduction instruction data (instructions) specifying whether certain of the image data is to be output (column 5, lines 9-24) for being selectively reproduced in response to the memory medium reading device reading the image-reproduction instruction data (column 2, lines 43-47) and determining whether the image reproduction instruction data is in an on-state or off-state (column 7, lines 12-40 and column 6, lines 32-54).

55- should
be rejected
with 52,
the additional
feature is
cited in Cb/14-16

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With regard to claims 6, 7, 8, 11, 15, 21, 27, 31, 39, 40, 41, 42, 47, 52, 57, 59, and 61, Parulski discloses an image output control method for use with a recording medium (24) storing image data for a plurality of images (the abstract, lines 10-14 and column 2, lines 38-39) and image-reproduction instruction data (instructions) specifying whether certain of the image data is to be output (column 5, lines 9-24) for being selectively reproduced in response to the memory medium reading device reading the image-reproduction instruction data (column 2, lines 43-47), and determining whether the image reproduction instruction data is in an on-state or off-state (column 7, lines 12-40 and column 6, lines 32-54), comprising a function of recognizing mounting of the recording medium (column 5, lines 35-39); reading the instruction data recorded on the recording medium based on the recognition (column 5, lines 35-51), and performing image generation for output by selectively reading necessary image data from the information recording medium in accordance with the instruction data (column 8, lines 1-33); output means (6a) for outputting the output data; data display means (6b) for displaying the image data and instruction data, and data processing means for analyzing the instruction data (column 5, lines 32-51), and means for recognizing the number of prints to be output (column 6, lines 14-16).

With respect to claims 4, 29, 33, 45, 49, and 65, Parulski discloses that the instruction data is provided for the name (classification) of each data (column 4, line 56 to column 5, line 8).

With regard to claims 5, 30, 34, 46, 50, and 66, Parulski discloses instructing the image data to be selectively reproduced and stored in a specific file (column 5, lines 1-8).

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With regard to claims 9, 10, 12, 13, 14, 16, 17, 18, 19, 20, 22-26, 70, 75, 76, and 77, Parulski discloses determining whether the instruction data is stored in the medium, and when it is, selectively outputting the instructed image data, and if it is determined that the instruction data is not stored in the medium, using a program incorporated within the apparatus (column 5, lines 32-51).

With respect to claims 53, 54, and 60, Parulski discloses displaying a summary of data to be selectively output and displaying data for specifying data recorded in the recording medium and information indicating whether instructions are present (column 2, lines 2-13 and column 5, line 52 to column 6, line 43).

With respect to claim 58, Parulski discloses means for editing data of the recording medium (column 6, lines 17-43).

With respect to claims 35, 36, 37, 38, 67, 68, 69, 71, 72, 73, 74, 78, and 79, Parulski discloses a display for displaying a soft copy output (column 5, line 52 to column 6, line 43) and a printer (6a) for producing a hardcopy output.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski in view of Kurihara et. al. (hereinafter referred to as Kurihara) (U. S. 5,901,278).

Parulski differs from claim 56 in that he does not clearly disclose performing an alarm display when the number of prints to be output is larger than the number of outputtable prints. Kurihara discloses an alarm displayed when a memory data over flow signal is detected (column 3, lines 7-14 and 45-57). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Parulski to perform an alarm display when the number of prints to be output is larger than the number of outputtable prints. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Parulski by the teaching of Kurihara in order to improve the printing process.

Response to Arguments

10. Applicant's arguments filed 1/2/2001 have been fully considered but they are not persuasive.

Applicant submits that Parulski does not disclose specifying whether certain of the image data is to be output for being selectively reproduced in response to the memory medium reading device reading the image-reproduction instruction data, and determining whether the image reproduction instruction data is in an on-state or off-state. The Examiner respectfully disagrees. Parulski discloses storing code for processing image data on a removable memory along with the

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images and downloading the stored images according to the stored categories (column 8, lines 13-25), specifying whether certain of the image data is to be output (column 5, lines 9-24), and determining whether the image reproduction instruction data is in an on-state (activated) or off-state (column 7, lines 12-40 and column 6, lines 32-54).

Conclusion

11. All claims are rejected.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Wallerson whose telephone number is (703) 305-8581.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

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Commissioner of Patents and Trademarks
Washington, DC 20231

or faxed to:

(703) 308-9051 (for formal communications intended for entry)

(703) 305-9731 (for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")


or hand-carried to:

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